

REMARKS

As a preliminary matter, the Examiner is thanked for making the references cited in the Information Disclosure Statement of record and returning to the undersigned attorney the initialed Forms PTO-1449.

Reconsideration of the application in view of the above amendments and following remarks is respectfully requested.

Claims 11 and 15-21 are pending in the subject application. As set forth above, claims 11 and 18 are amended. Claim 11 has been amended to enhance the clarity of the subject matter as claimed. Support for the amendment is found, for example, at page 47, lines 5-15 and pages 97-98 of the specification. Claim 18 has been amended to depend directly from independent claim 11. No new matter has been introduced by the amendments. Claims 11 and 15-21, as amended herein, are pending in the subject application.

In the Office Action dated May 2, 2008, claims 11 and 15-21 were rejected under 35 U.S.C. § 101 as lacking “patentable utility.” This rejection is respectfully traversed.

As set forth above, amended claim 11 (and thus claims 15-21 which depend therefrom) of the subject application is directed to an *in vitro* method of inhibiting VEGF production in a cell from a tumor of a patient in need of treatment. This is an *in vitro* method that utilizes tumor cells from patients that are in need of therapy and who are potential candidates for receiving *in vivo* a compound that inhibits VEGF production. A utility of the amended pending claims is to determine whether a particular tumor from an individual cancer patient is responsive to a specific compound *in vitro* in order to assess whether the patient is a candidate for receiving the compound *in vivo*. Applicants submit that amended claims 11 and 15-21 satisfy the utility requirement of Section 101.

Therefore, Applicants believe that the rejection of claims 11 and 15-21 under 35 U.S.C. § 101 has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action, claims 11 and 15-21 were rejected under 35 U.S.C. § 112, first paragraph, as lacking enablement. It is stated in the Office Action that the specification “provides no enablement for the treating of any condition in animals.” This rejection is respectfully traversed.

The amendment of claim 11 (and thus claims 15-21 which depend therefrom) renders this rejection moot. As described above, the amended claims are not claims directed to treating conditions in animals. The amended claims are directed to an *in vitro* method and not an *in vivo* method.

Therefore, Applicants believe that the rejection of claims 11 and 15-21 under 35 U.S.C. § 112, first paragraph, has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action, claims 18-20 were rejected under 35 U.S.C. § 112, second paragraph, as indefinite. Claim 18 (and therefore claims 19 and 20 which depend directly or indirectly from claim 18) was objected to based on its dependency on claim 17. This rejection is respectfully traversed.

As set forth above, claim 18 has been amended to depend directly from independent claim 11 and not from dependent claim 17. Accordingly, the grounds for rejection has been eliminated.

Therefore, Applicants believe that the rejection of claims 18-20 under 35 U.S.C. § 112, second paragraph, has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action, claims 11 and 15-20 were rejected under 35 U.S.C. § 102(b) as anticipated by Chiarino et al. (European Patent Application Publication No. 284017). It is stated in the Office Action that the compounds of Chiarino et al. are “useful in treating arthritis which is known to be treatable with VEGF inhibitors.” This rejection is respectfully traversed.

Amended claim 11 (and thus claims 15-21 which depend therefrom) of the subject application is directed to an *in vitro* method that utilizes tumor cells from patients. Chiarino et al. was cited in the Office Action for compounds which are useful in treating arthritis. Applicants' amended claims 11 and 15-21 are not directed to a method for treating arthritis. Claims 11 and 15-21 are not directed to compounds *per se*, so even if any overlap were to exist between the compounds disclosed in Chiarino et al. and those disclosed in the subject application, this does not affect the patentability of Applicants' claimed method which differs from that of Chiarino et al. Accordingly, Applicants' amended claims 11 and 15-21 are not anticipated within the meaning of Section 102(b) by the disclosure of Chiarino et al.

Therefore, Applicants believe that the rejection of claims 11 and 15-21 under 35 U.S.C. § 102(b) over Chiarino et al. has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action, claims 11 and 15-21 were rejected under 35 U.S.C. § 103(a) as unpatentable over Walsh et al. (Arthritis Research 3:147-153, 2001) in view of Chiarino et al. (European Patent Application Publication No. 284017). It is stated in the Office Action that Walsh et al. teaches that angiogenesis which is stimulated by VEGF contributes to inflammatory disease and that angiogenesis inhibitors may reduce inflammation. It is also stated that Chiarino et al. discloses that 3-thiazoyl coumarins are useful in treating inflammatory conditions, such as arthritis. This rejection is respectfully traversed.

Walsh et al. is concerned with the pathogenesis of inflammatory disease in the synovial joint and the lung. Such inflammatory diseases are said to include rheumatoid arthritis, osteoarthritis, asthma, and pulmonary fibrosis. Chiarino et al. is concerned with compounds purported to have anti-arthritic activity. Amended claim 11 (and thus claims 15-21 which depend therefrom) of the subject application is directed to an *in vitro* method that utilizes tumor cells from patients. Amended claims 11 and 15-21 are not directed to inflammatory diseases, including not to arthritis. Walsh et al. and Chiarino et al., taken alone or in combination, do not teach or even suggest the subject matter of Applicants' amended claims 11 and 15-21. Accordingly, it is respectfully submitted that the disclosure of the combination of Walsh et al. and Chiarino et al. does not establish within the meaning of Section 103(a) a *prima facie* case for obviousness of amended claims 11 and 15-21.

Therefore, Applicants believe that the rejection of claims 11 and 15-21 under 35 U.S.C. § 103(a) over Walsh et al. in view of Chiarino et al. has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

In the Office Action, claims 11, 15, 16 and 18-20 were rejected under 35 U.S.C. § 102(a) as anticipated by Srimanth et al. (Arzneim.-Forsch./Drug Res. 52, No. 5, 388-392, 2002). The rejection is respectfully traversed.

As set forth above, amended claim 11 (and thus claims 15-21 which depend therefrom) of the subject application recites in part: “An *in vitro* method of inhibiting VEGF production in a cell from a tumor of a patient in need of treatment...” Accordingly, the pending claims require that the cell be from a tumor of a patient in need of treatment and that the compound inhibit VEGF production.

Srimanth et al. is stated at page 4 of the Office Action to disclose compounds which “showed very good activity against different tumor cell lines.” A review of Srimanth et al. finds that the only description of the assay is the short section entitled “2.2 Pharmacology” at page 392. The results are stated to represent the drug concentration producing 50% inhibition of cell growth. There is no teaching that the compounds tested by Srimanth et al. inhibit VEGF production. Based on the disclosure of Srimanth et al., one of ordinary skill in the art could not know whether the compounds tested therein would be useful to inhibit VEGF production. In addition, the disclosure of Srimanth et al. does not reveal whether the cell lines used therein were from a tumor of a patient in need of treatment. Accordingly, Srimanth et al. does not teach all the requirements of claim 11 (and thus also not of claims 15-21 which depend therefrom).

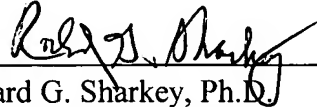
Therefore, Applicants believe that the rejection of claims 11, 15, 16 and 18-20 under 35 U.S.C. § 102(a) over Srimanth et al. has been overcome. Reconsideration and withdrawal of this rejection are respectfully requested.

Therefore, in light of the amendments and remarks set forth above, Applicants believe that all the Examiner’s rejections have been overcome. Reconsideration and allowance of the pending claims (11 and 15-21) are respectfully requested. If there is any further matter requiring attention prior to allowance of the subject application, the Examiner is respectfully requested to contact the undersigned attorney (at 206-622-4900) to resolve the matter.

The Director is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to Deposit Account No. 031182.

Respectfully submitted,

Seed Intellectual Property Law Group PLLC

A handwritten signature in black ink, appearing to read "Richard G. Sharkey", is written over a horizontal line.

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